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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,647	06/07/2000	Joe McCollum	C1151-7000	8728
37462 7590 01/27/2009 LOWRIE, LANDO & ANASTAS, LLP ONE MAIN STREET, SUITE 1100 CAMBRIDGE, MA 02142				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ll-a.com  
engelsson@ll-a.com

# Office Action Summary

**Application No.**

09/589,647

**Applicant(s)**

MCCOLLUM ET AL.

**Examiner**

Natalie A. Pass

**Art Unit**

3686

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 November 2008 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed on 7 November 2008. Claims 1, 2, and 16 have been amended. Claims 1-26 remain pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3-9, 16-22, 25-26 are rejected under 35 U.S.C. § 101.

A) As per claims 1, 3-9, 16-22, 25-26, these appear to be directed toward a method or process of obtaining or ordering a patient record. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject

matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., a "cover letter") is not a transformation because a cover letter is not statutory subject matter. Thus, claims 1, 3-9, 16-22, 25-26 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 10-15, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 2 recites limitations in “*means plus function*” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

It is of note that recent court cases have held that simply reciting “software” without providing some detail about the means to accomplish the function is not enough. See *Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, \_\_\_ F.3d \_\_\_, 2008 U.S. App. LEXIS 6472, at \*10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). The Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the

claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the algorithm that transformed the general purpose microprocessor to a “special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming*, 184 F.3d at 1349. Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

In the instant case, the “*means plus function*” language recited in claim 2 lacks sufficient disclosed structure under 112, sixth paragraph, and is therefore indefinite under 112, second paragraph.

(B) Claims 10-15, 23-24 incorporate the features of independent claim 2, through dependency, and are also rejected.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 8-12, 14-18, 20-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Shelton, United States Patent 7, 028, 049 for substantially the same reasons as in the previous Office Action (paper number 20080309). Further reasons appear hereinbelow.

(A) As per amended claim 1, Shelton teaches a method of obtaining a patient record containing information concerning an identified patient using an online location on an electronic medium (Shelton; Figure 1, column 9, lines 1-8), comprising:

requesting an order, by a requestor, for the patient record concerning the identified patient from the online location (Shelton; Figure 1, column 9, lines 9-17, 40-45, column 10, lines 5-10);

providing to the requestor a cover letter having "a tracking number" (reads on "an identifier") (Shelton; column 12, lines 50-55) identifying the order requested from the online location (Shelton; column 10, lines 28-40, column 10, line 33 to column 11, line 3, column 13, lines 10-26);

providing to the requestor, by the identified patient, a patient authorization letter authorizing release of the patient record concerning the identified patient (Shelton; column 11, lines 4-9);

sending, by the requestor to an "Approvals Agent" (reads on "a processing center"), after providing to the requestor the "order form" [reads on "cover letter"] and after providing to the requestor the patient authorization letter, the cover letter along with the patient authorization letter to an "Approvals Agent" (reads on "a processing center"), for completing the order (Shelton; column 10, lines 33-39, column 11, lines 4-30, 49-52, column 12, lines 4-9); Examiner

interprets Shelton's teachings of providing to the requester "an order form indicating all of the approvals required before the holder will release it ... [...] ... specify the approximate time period required to retrieve and deliver the information once all approvals are complete, the available type(s) of media on which the document can be delivered and the cost (if any) for this information to be forwarded to the requesting party" (Shelton; column 10, lines 33-39) together with Shelton's teachings of "a patient may give prior approval ... [...] ... the automatic pre-authorization by such patient for the release of his medical data to such doctor or medical institution. ... [...] ... The second stage search service begins when the doctor submits a completed order form ... [...] ... Approvals Agent 16 acts as a message-passing server, responding to the orders it receives ... [...] ... and in turn, contacts other resources over the network or via fax ... [...] ... such persons will be other clients 10a and 10c, but could be persons outside the user's with known connections to the Internet ... [...] ... immediate processing once the required approvals are secured" (Shelton; column 11, lines 4-30) and Shelton's teachings of "if a standing provision has been given by the party for release of their records in the specific circumstances fulfilled by the requester, then such approvals will be granted automatically" (Shelton; column 11, lines 49-52) to teach a form of this limitation;

in response to the requestor sending the cover letter and the patent authorization letter, "[w]hen Approvals Agent 16 receives all of the required authorizations for release of the records request" (reads on "after receiving from the requestor the cover letter and the patent authorization letter,") requesting, by the "Approvals Agent" (reads on "processing center") to a "data administrator" (reads on "shipping location") to "retrieve and transmit" (reads on "ship")



the patient record concerning the identified patient to “the requesting physician” (reads on “a destination location”) (Shelton; column 12, lines 4-9); and

obtaining, by the requestor, the patient record concerning the identified patient from the destination location (Shelton; column 13, lines 10-27).

(B) As per claims 3-6, 8-9, 21-22, Shelton teaches a method as analyzed and discussed in claim 1 above

wherein the online location comprises a web site (Shelton; column 5, lines 27-31, column 13, lines 22-26);

wherein the requestor comprises an insurance company (Shelton; Figure 1, column 9, lines 9-15);

further comprising inputting patient information in a graphical user interface window before requesting the order (Shelton; column 10, lines 28-35); and

wherein the patient information includes at least one of a claim number, first name, last name, social security number, and date of birth (Shelton; column 10, lines 5-8);

wherein sending the cover letter comprises faxing the cover letter to the processing center (Shelton; column 11, lines 10-20); and

further comprising “automatically obtain[ing] important customized information tailored to each individual data item” (reads on “ automatically reading and identifying, by the processing center, the identifier on the cover letter (Shelton; column 10, line 64 to column 11, line 3);

wherein said cover letter is a “conventional” (reads on “paper”) letter (Shelton; column 10, lines 58-61); and

wherein said patient authorization letter is a “conventional” (reads on “paper”) letter (Shelton; column 10, lines 58-61).

(C) Amended claim 2 differs from amended method claim 1, in that it is a system rather than a method for obtaining a patient record containing information concerning an identified patient using an online location.

System claims 2, 10, 11, 12, 14, 23-24 repeat the subject matter of claims 1, 4, 3, 5, 8, 21-22, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claims 1, 4, 3, 5, 8, 21-22 have been shown to be fully disclosed by the teachings of Shelton in the above rejection of claims 1, 4, 3, 5, 8, 21-22 it is readily apparent that the system disclosed by Shelton includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 4, 3, 5, 8, 21-22 and incorporated herein.

(D) As per claim 15, Shelton teaches a system as analyzed and discussed in claim 2 above

wherein sending the cover letter comprises mailing the cover letter to the processing center (Shelton; column 9, lines 33-34, column 10, lines 59-61).

(E) Claim 16 differs from claim 1 in that it is a method of ordering, by a requestor, a patient record containing information concerning an identified patient using an online location rather than a method of obtaining a patient record containing information concerning an identified patient using an online location on an electronic medium.

Claims 16-18, 20, 25-26 repeat the features of claims 1, 4, 5, and 8, 21-22, respectively, and are therefore rejected for the same reasons given above in the rejections of claims 1, 4, 5, and 8, 21-22, and incorporated herein.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton, United States Patent 7, 028, 049, as applied to claims 1, 2, and 16 above, and further in view of Hacker, United States Patent 6, 988, 075, for substantially the same reasons as in the previous Office Action (paper number 20080309). Further reasons appear hereinbelow.

(A) As per claim 7, Shelton teaches a method as analyzed and discussed in claim 1 above.

Shelton fails to explicitly disclose a method wherein the identifier comprises a bar code.

However, the above features are well known in the art, as evidenced by Hacker.

In particular, Hacker teaches a method wherein the identifier comprises a bar code (Hacker; column 6, lines 24-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Shelton to include these limitations, as taught by Hacker, with the motivations of “provid[ing] remote access to electronic medical records by patients or patient-authorized medical providers via a network, such as the Internet, using ordinary browser software” and “provid[ing] patient control over access to their records by using ... [an] ... identifier in order to access the electronic medical record” (Hacker; column 6, lines 20-28).

(B) Claim 13 differs from method claim 7, in that it is a system rather than a method for obtaining a patient record containing information concerning an identified patient using an online location.

System claim 13, repeats the subject matter of claim 7, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 7 have been shown to be fully disclosed by the combined teachings of Shelton and Hacker in the above rejection of claim 7, it is readily apparent that the system disclosed by Shelton includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 7, and incorporated herein.

The motivations for combining the respective teachings of Shelton and Hacker are as given in the rejection of claim 7 above, and incorporated herein.

(C) Claim 19 teaches a method as analyzed and discussed in claim 16, above. Claim 19 repeats the features of claim 7, respectively, and is therefore rejected for the same reasons given above in the rejections of claim 7, and incorporated herein.

The motivations for combining the respective teachings of Shelton and Hacker are as given in the rejection of claim 7 above, and incorporated herein.

***Response to Arguments***

11. Applicant's arguments filed 7 November 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 7 November 2008.

(A) As per Applicant's arguments on page 7, paragraph 3 of the 7 November response regarding a previous rejection under 35 USC § 112, Examiner respectfully notes that no such rejection made was for the claim language discussed; however Examiner thanks Applicant for providing more clearly recited claim language.

(B) At pages 10-11 of the 7 November 2008 response, Applicant argues that the limitations claimed in Applicant's invention are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 7 November 2008 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Shelton and Hacker, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §102 and §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20080309), and incorporated herein. In particular, Examiner notes that sending, by the requestor to an "Approvals Agent" (reads on "a processing center"), after

providing to the requestor the “order form” [reads on “cover letter”] and after providing to the requestor the patient authorization letter, the cover letter along with the patient authorization letter to an “Approvals Agent” (reads on “a processing center”), for completing the order (see Shelton; column 10, lines 33-39, column 11, lines 4-30, 49-52, column 12, lines 4-9), and in response to the requestor sending the cover letter and the patient authorization letter “[w]hen Approvals Agent 16 receives all of the required authorizations for release of the records request” (reads on “after receiving from the requestor the cover letter and the patient authorization letter,”) requesting, by the “Approvals Agent” (reads on “processing center”) to a “data administrator” (reads on “shipping location”) to “retrieve and transmit” (reads on “ship”) the patient record concerning the identified patient to “the requesting physician” (reads on “a destination location”) (Shelton; column 12, lines 4-9) are taught by the applied references.

At page 10, paragraph 1 of the 7 November 2008 response Applicant argues that in the applied Shelton reference “the actions are performed in different orders” to Applicant’s recited invention. Examiner respectfully disagrees, and notes that the Shelton reference teaches different embodiments, including varying orders of performance of actions, including, as discussed earlier in this Office Action, the order of actions recited in the claimed invention.

At page 10, paragraph 2 of the 7 November 2008 response Applicant argues that “[a]ccording to the claimed invention, the requestor consolidates the order ... [...] ....” Assuming that by “consolidates” Applicant means “completes,” Examiner respectfully disagrees. Examiner respectfully notes that the limitation in claim 1 recites “sending, by the requestor to a processing center, ... [...] ..., the cover letter along with the patient authorization letter to a processing

center, for completing the order” (emphasis added) which Examiner interprets to recite that it is the processing center that completes the order. Furthermore, Examiner respectfully submits that Applicant’s own Specification appears to agree with this interpretation, by stating “[o]nce the EHI processing center 14 receives the cover letter 600 and patient’s authorization letter, the order is processed in step 420” (Spec., page 13, lines 5-6), and then “[u]pon receipt of all the requested records, an EHI employee will put an entry into the EHI web site 12 stating that the records and documents have been received and the order status will be changed to ‘complete’” (Spec., page 13, line 21 to page 14, line 1). As such, it appears to be the processing center that consolidates or completes the order in Applicant’s invention.

In response to Applicant’s arguments at page 10, paragraph 2 to page 11, line 2 of the 7 November 2008 response that “[t]he system of Shelton is intended to separate the actions of the requestor from the actions of the approver... [...] ... whereas the present invention finds application where the requestor and the approver are working in close cooperation ... [...] ...” Examiner respectfully notes that these are not claimed limitations.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to Applicant’s disclosure. The cited but not applied references, Johnson, U.S. Patent Number 6915265, Koo, et al., U.S. Patent Number 6874085, Rabin, U.S. Patent Number 6603464, Sparks, U.S. Patent Application Publication Number 2001/0037215, Segal et al., U.S. Patent Application

Publication Number 2001/0041991, and Brickell et al., U.S. Patent Application Publication Number 2002/0083014, teach the environment of authorizing access to medical records.

13. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications



may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3626  
January 20, 2009

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686